

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masaki Nakai

Application No.: 10/067,428

Confirmation No.: 7889

Filed: February 7, 2002

Art Unit: 3692

For: ONLINE SHOPPING SETTLEMENT
METHOD AND SYSTEM, AND ONLINE
SHOPPING SETTLEMENT PROGRAM

Examiner: Ojo O. Oyebisi

RESPONSE TO RESTRICTION REQUIREMENT AND CONDITIONAL PETITION

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed May 2, 2007, applicant hereby provisionally elects claims 2-13 for continued examination, with traverse.

The Examiner has required restriction between Groups I (claim 1), II (claims 2-13) and III (claims 14-38).

A. The Groups are not Related As Sub-Combinations Usable Together

The position was taken in the Office Action that the groups are related as sub-combinations usable together. This is not the case. First, Groups I and III and Groups II and III cannot related to one another as sub-combinations usable together at least because claim 1 (drawn to Group I) and Claims 2-13 (drawn to Group II) are method claims while claims 14-38 (drawn to

Group III) are *system* claims. A method and a system cannot be said to be related as sub-combinations usable together. For at least this reason, the restriction is defective and should be withdrawn.

Moreover, while claim 1 and claim 2 are of somewhat different scope, claim 2 generally relates to subject matter related to that of claim 1, but with some additional limitations. While the additional limitations make the claims somewhat different in scope from one another, they do not cause these claims relate to one another as sub-combinations usable together. In fact, they are not sub-combinations at all due at least because of the significant overlap in scope.

B. The Cited Groups Recite Related Subject Matter.

Various features were recited in the listing of Groups at pages 2 and 3 of the Office Action that allegedly differentiate the “utility and scope” of the Groups from one another. However, the alleged differences listed in the Office Action are not actually present.

For example, the Examiner stated on page 2 that “invention II online shopping settlement steps include recording said order slip and order confirmation slip thus detected, where invention III online shopping settlement steps include an order slip monitoring.” In fact, “invention II,” e.g., claim 2, also has the order slip monitoring, which the Office Action seems to associate with Group III. Moreover, “invention III,” e.g., claim 15, also recites the recording of the order slip and order confirmation slip thus recorded, which is the feature the Office Action seems to associate with Group II. That is, both groups actually have all the features listed by the Examiner.

Similar factually incorrect characterizations are found in the comparisons between Groups I and II, at the bottom of page 2, and between Groups I and III. For at least these additional reasons, the restriction is defective.

In fact, claim 14 is a system claim substantially corresponding to method claim 1, while claims 15-38 are system claims substantially corresponding to method claims 2-13. It is quite clear from the foregoing that a search for all of the claims would be co-extensive and not be an undue burden on the Patent Office.

For at least the reasons set forth above, the restriction should be withdrawn and the claims Examined together. If the Examiner does not withdraw the Restriction, this paper is to be considered a Petition for withdrawal of the restriction requirement and passed to the appropriate authorities for decision on such Petition. The Petition fee, if necessary, can be charged to Deposit Account No. 50-2215.

It is respectfully requested that the restriction requirement be withdrawn, for at least the reasons set forth above, and that each of claims 1-38 presently pending in this application be examined.

Dated: June 4, 2007

Respectfully submitted,

By /Michael J. Scheer/
Michael J. Scheer
Registration No.: 34,425
DICKSTEIN SHAPIRO LLP
1177 Avenue of the Americas
41st Floor
New York, New York 10036-2714
(212) 277-6500
Attorney for Applicant